

Docket: 71360 (US02)

PATENT

REMARKS

Upon entry of the above amendment, Claims 48 and 51 – 59 are pending in this application. The amendments to the claims do not present new matter; support may be found generally in the specification and, specifically, the claims as filed in the present divisional application (including as-filed in the parent application).

Restriction

The Examiner restricted present claims 48 and 51 – 59 into six groups based upon the value of "n" in the lactam ring. The restriction is set forth at pages 2-3 of the Office Action mailed June 22, 2004. In a telephone interview with the Examiner, Applicants provisionally elected, with traverse, the claims of Group III. That is, all claims 48 and 51 – 59 were elected, but the value of "n" for purposes of examination was limited to "2." Applicants hereby affirm the election of Group III (i.e., n=2) for examination in the present application. Further, Applicants withdraw the previously stated traversal.

Priority

Applicants acknowledge the Examiner's helpful reminder concerning specific reference to prior applications. The first paragraph of the specification has been amended accordingly.

Claim Rejection under §112

The Examiner rejected claims 48 and 51 – 59 under 35 USC §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim that which the Applicants regard as the invention. (Office Action of June 22, 2004 at 4.) Applicants respectfully traverse the rejection.

The Examiner set forth two points of rejection at page 4 of the Office Action, the first of which concerns the term "C₄ to C₂₀ heteroaryl." According to the Examiner, the term is indefinite. While Applicants respectfully disagree with the Examiner's position and the statements made in support thereof, in an effort to expedite prosecution Applicants have removed the subject term from the remaining claims. Using the

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Examiner's helpful suggestion, the "heteroaryl" portion of the invention is now recited as "a 5- or 6- membered aromatic ring containing 1 to 3 heteroatoms selected from the group consisting of oxygen, sulfur and nitrogen." The amended language finds support in the specification at page 4, lines 13-14. Applicants respectfully submit that the foregoing point of rejection has been rendered moot.

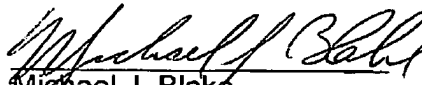
In addition, the Examiner states that the term "substituted . . . without saying which substituents are intended is indefinite." (Office Action at 4.) Applicants again respectfully disagree; one of skill in the art reading the claims in light of the specification would clearly know and understand what is intended by the term "substituted." Nevertheless, in an effort to expedite prosecution, Applicants have included specific substituents listed in the specification at pages 3-4 into the claims at the Examiner's request. Applicants respectfully submit that the foregoing point of rejection is moot.

In light of the foregoing remarks, Applicants respectfully submit that the rejection of the claims under §112, second paragraph, should be withdrawn.

In summary, applicant believes that all pending claims in the application (claims 48 and 51- 59) are in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection and withdraw the rejections and pass the application to issuance.

Respectfully submitted,

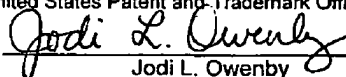
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I hereby certify that this paper (along with any paper(s) referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on the date shown below.


Jodi L. Owenby

12/21/2004
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